

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Application No.: 10/561503 Confirmation No.: 6419
Filed: July 27, 2004 Group Art Unit 1772
Title: DOUBLE-SIDED PRESSURE-SENSITIVE ADHESIVE SHEET

BRIEF ON APPEAL

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Commissioner for Patents
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Dear Sir:

This is an appeal from the Office Action mailed on February 13, 2008, in light of the Advisory Action mailed May 19, 2008, finally rejecting claims 11, 13-16 and 21-26.

A Notice of Appeal in this application was mailed on June 13, 2008, and was received in the USPTO on June 13, 2008.

Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

Fees

- ☒ Any required fee under 37 CFR § 41.20(b)(2) will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 37 CFR § 41.20(b)(2) and 1.17 which may be required to Deposit Account No. 13-3723. (One copy of this sheet marked duplicate is enclosed.)
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

TABLE OF CONTENTS

Real Party In Interest	4
Related Appeals And Interferences	4
Status of Claims	4
Status of Amendments	4
Summary Of Claimed Subject Matter.....	5
Grounds of Rejection to be Reviewed on Appeal.....	7
Argument	8
I. Claim 11, 13-16 and 21-26 stand rejected under 35 USC § 102(b) as being anticipated by JP 2002-23663	8
A. Independent claim 21 and dependent claims 11 and 13-16.	8
B. Dependent claims 13-16.....	10
C. Independent claim 22 and dependent claims 23-26.....	11
Conclusion	12
Claims Appendix	13
Evidence Appendix None	15
Related Proceedings Appendix None.....	16

REAL PARTY IN INTEREST

The real party in interest is 3M Company and its affiliate 3M Innovative Properties Company of St. Paul, Minnesota.

RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1-10, 12 and 17-20 were cancelled.

Claims 11, 13-16 and 21-26 are pending.

Claims 11, 13-16 and 21-26 stand rejected.

Claims 11, 13-16 and 21-26 are on appeal.

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STATUS OF AMENDMENTS

No amendments have been filed after the final rejection.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 21 provides a double-sided pressure-sensitive sheet. One exemplary double-sided pressure-sensitive sheet according to claim 21 is shown in FIG. 2, as reproduced below.

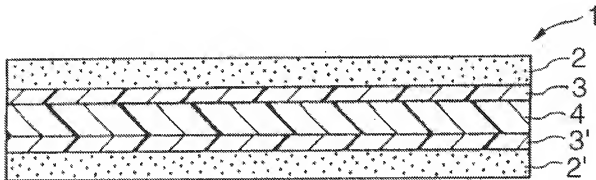


Fig. 2

Double-sided pressure-sensitive sheet (1) comprises, in the following order, a first pressure-sensitive adhesive layer (2), a first black layer (3), a flexible base layer (4), a second black layer (3'), and a second pressure-sensitive adhesive layer (2'). (See page 4, lines 25-28.) As shown in FIG. 1, the first pressure-sensitive adhesive layer (2) and second pressure-sensitive adhesive layer (2') are the outermost layers on either side of the double-sided pressure-sensitive sheet (1). (See, e.g., page 3, lines 3-8). Also, the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm . (See, e.g., page 6, lines 18-20; and page 10, lines 10-13.)

Exemplary black layers are described at page 7, line 10 – page 8, line 13. Exemplary pressure sensitive adhesives are described t page 6, lines 1-20. Exemplary flexible base layers are described at page 6, line 22 – page 7, line 8.

Dependent claim 13 depends from claim 21 and further requires a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer. (See layer (6) of Fig. 4.) Exemplary reflective layers are described at page 8, line 15 – page 9, line 25.

Independent claim 22 also provides a double-sided pressure-sensitive sheet. One exemplary double-sided pressure-sensitive sheet according to claim 21 is shown in FIG. 3 as reproduced below.

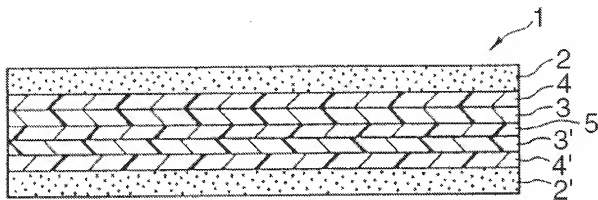


Fig. 3

Double-sided pressure-sensitive sheet (1) comprises, in the following order, a first pressure-sensitive adhesive layer (2), a first flexible base layer (4), a first black layer (3), a lamination layer (5), a second black layer (3'), a second flexible base layer (4'), and a second pressure-sensitive adhesive layer (2'). As shown in FIG. 4, the first pressure-sensitive adhesive layer and said second pressure-sensitive adhesive layer are the outermost layers on either side of the double-sided pressure-sensitive sheet. Also, the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm . (See, e.g., page 7, lines 1-7.)

The lamination layer may be any means suitable for bonding laminates together, e.g., a hot-melt adhesive. (See page 5, lines 20-24.)

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Claim 11, 13-16 and 21-26 stand rejected under 35 USC § 102(b) as being anticipated by JP 2002-23663.

ARGUMENT

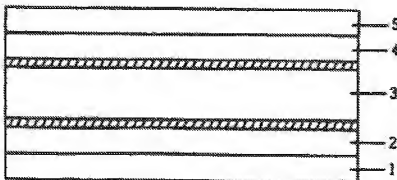
I. Claim 11, 13-16 and 21-26 stand rejected under 35 USC § 102(b) as being anticipated by JP 2002-23663

Anticipation under 35 U.S.C. § 102 requires that “every element of the claimed invention must be identically shown in a single reference” (see, e.g., *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (internal citations omitted)). As the Patent Office has failed to show how JP 2002-23663 (JP '663) identically discloses each element of the claimed invention, the pending rejections under 35 USC § 102(b) are clearly in error and must be reversed.

A. Independent claim 21 and dependent claims 11 and 13-16.

As described in the Summary of Claimed Subject Matter, and as shown in representative FIG. 2 included therein, claim 21 requires two black layers in a multilayer structure. The relative positions of the various layers are also set forth in claim 21.

The figure below is taken from JP '633. Based on the description of this figure, elements 1 and 5 are separators. Both Appellants and the Patent Office agree the separators are not relevant to the claimed structure. (See, e.g., Final Office Action dated February 13, 2008, Section 4.) The remaining elements are described as an adhesive layer (4), a metal vapor deposited layer (the crosshatched layer), a plastic film (3), a second metal vapor deposited layer (the crosshatched layer), and a second adhesive layer (2). (See page 7, [Legend], and the description of FIG. 1 at page 5, paragraph [0013].)



The Patent Office has failed to show how this embodiment or any other portion of JP '633 identically discloses any independent elements corresponding to the required first black layer and second black layer of claim 21. That is, although JP '663 notes that an adhesive layer may be mixed with a black layer (see, page 5, paragraph [0012]), claim 21 requires two separate adhesive layers and two separate black layers.

The Patent Office has relied on page 5, paragraph [0011], lines 10-27 as support for the purported teaching of both a first and a second black layer. (Final Office Action dated February 13, 2008; at page 2.) However, the cited passage merely refers to possibility of including a white or black pigment in an adhesive layer or the "protective layer." As discussed above, regardless of whether the adhesive layers of JP '663 may be black, this does not anticipate the present claims which require two black layers in addition to two adhesive layers. Thus, if JP '663 teaches a black layer within the meaning of claim 21, it must be the protective layer.

At best, JP '663 describes articles which may include one protective layer, but fails to describe the use of two protective layers. Specifically, at page 3, paragraph [0005], JP '663 describes an adhesive sheet that is characterized by that "the sheet is layered in the order of separator, adhesive layer and substrate having at least two metal vapor deposited layers." JP '663 further requires the adhesive sheet have "a structure in which metal vapor deposited layer is not exposed to the other side of the said adhesive layer excluding the separator."

Referring to page 4, paragraph [0008], JP '663 describes one substrate sheet as follows:

The substrate sheet which normally uses plastic films and is most advantageous costwise is either installed with a protective layer on the opposite side of metal vapor deposited plastic film which is vapor deposited with metals such as aluminum and silver on both sides or other adhesive layer contacting the above mentioned adhesive layer and a separator are installed In the order described above and in this case, metal vapor deposited layer has two layers and normally two layers of metal deposited layer can achieve the objective of this invention. In such condition, "plastic film metal vapor deposited on both sides + protective layer" is treated as a "substrate sheet" for the sake of convenience when a protective layer is installed ...

These passages appear to describe a structure comprising, in order, a separator, and adhesive layer, a metal vapor deposited layer, a substrate, a second metal vapor deposited layer, and some additional "protective layer" which prevents this second metal vapor deposited layer from being exposed. (Additional support for this interpretation can be found at page 3,

paragraph [0005] wherein JP '663 defines the phrase “the structure in which metal vapor deposited layer is not exposed on the opposite side of the said adhesive layer.”)

Thus, at best, JP '663 may describe an adhesive article that includes one protective layer, but fails to describe, teach or suggest either the presence of or the need for a second protective layer. Therefore, regardless of whether JP '663 may teach that the protective layer may include black pigment, the Examiner has failed to show how JP '663 describes each element of the claimed invention, e.g., two black layers and two adhesive layers.

For at least these reasons, the rejection of independent claim 21 under 35 USC § 102(b) as being anticipated by JP2002-23663 is unwarranted and should be withdrawn.

Claims 11 and 13-16 depend from claim 21 and add patentable feature thereto. Claim 21 is patentable over JP '663, thus claims 11 and 13-16 are likewise patentable and the rejection of these claims should be reversed as well.

B. Dependent claims 13-16

Claim 13 depends from claim 21 is patentable for at least the reasons stated above. In addition, claim 13 further requires a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer. According to the Patent Office, page 4, column 2, lines 1-10 of JP '663 teaches a laminate further comprising a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer. (See Final Office Action dated February 13, 2008 at page 3.)

In response, Appellants noted that the passage cited by the Patent Office appeared to refer to structures including additional metal vapor deposited layers. The described structures can also include a protective layer. However, Appellants informed the Patent Office that they were not able to identify any reference to a black “protective layer” or any other black layer located between a reflective layer and an adhesive layer. (Response dated April 11, 2008 at page 6.) Appellants then requested that the Patent Office provide further explanation or withdraw the rejection.

In the following Advisory Action dated February 13, 2008, the Patent Office failed to provide any further details regarding which layer of JP '663 the Patent Office regards as being “a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer.”

For at least these reasons, Appellants submit that the Patent Office has failed to show how JP '663 identically discloses all elements of claim 13. Therefore, the rejection of claim 13 is unwarranted and should be withdrawn. Claims 14-16 depend from claim 13. As claim 13 is patentable for at least the reasons stated above, the rejection of claims 14-16 are also unwarranted and should be reversed.

C. *Independent claim 22 and dependent claims 23-26.*

As described in the Summary of Claimed Subject Matter, and as shown in representative FIG. 3 included therein, claim 22 requires two black layers in a multilayer structure. The relative positions of the various layers are also set forth in claim 22.

The Patent Office again relied on FIG. 1 and page 5, paragraph [0011], lines 10-27 of JP '663 as purportedly teaching such a structure. (See Final Office Action dated February 13, 2008 at page 3.) The Patent Office also relied on page 3, paragraph [0005]. (See Final Office Action dated February 13, 2008 at page 3.) The passage on page 3 recites:

Here, "the structure in which metal vapor deposited layer is not exposed on the opposite side of the said adhesive layer" can be achieved as explained later in detail, by a method ... [a description of a first method] ... or a method in which two pieces of plastic film which are metal vapor coated on one side are bonded by adhesive agent such as adhesive and in that case, metal vapor deposited layer of the plastic film which is metal vapor deposited on one side which is the side that can not be installed at least above mentioned adhesive layer, is bonded inside ...

This text appears to describe two pieces of plastic film which are each metal vapor coated on one side. The metal vapor deposited layer of one plastic film is adhesive bonded to the second piece of plastic film, which itself is also metal vapor deposited on one side. It is not clear whether the metal vapor deposited layer of the first plastic film is bonded to the metal vapor deposited layer of the second film, or if it is bonded to the second plastic film on the side opposite the second metal vapor deposited layer. (See page 4, paragraph [0008], which also appears to describe such structures.)

Regardless of the structure, since the black layers of the present invention are patentably distinct from the vapor deposited metal layers of JP '663, the Patent Office has failed to show how this passage describes, in order, a first black layer, a lamination layer, and a second black layer. Nor has the Patent Office shown how the addition of a protective layer in the locations

described by JP '663, even if it did contain black pigment, would anticipate the present claims. For at least these reasons, Appellants respectfully submit that the rejection of claim 22 under 35 USC § 102(b) as being anticipated by JP2002-23663 is unwarranted and should be withdrawn.

Claims 23-26 depend from claim 22 and add patentable feature thereto. Claim 22 is patentable over JP '663, thus claims 23-26 are likewise patentable.

CONCLUSION

For the foregoing reasons, appellants respectfully submit that the Patent Office has failed to show how JP '663 identically discloses all elements of the claimed invention. Absent such a showing, the Patent Office clearly erred in rejecting this application under 35 USC § 102(b). Therefore, Appellants respectfully request that the rejections be reversed and all pending claims allowed.

Respectfully submitted,

August 1, 2008

Date

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CLAIMS APPENDIX

1-10. (Canceled)

11. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 21, wherein said first black layer and second black layer are black printed layers formed on each side of the flexible base layer.

12. (Canceled)

13. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 21, wherein said laminate further comprises a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer.

14. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 13, wherein said reflective layer is a metal layer.

15. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 13, wherein said reflective layer is a white film.

16. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 13, wherein said reflective layer is a white printed layer.

17-20. (Canceled)

21. (Previously Presented) A double-sided pressure-sensitive sheet comprising, in the following order, a first pressure-sensitive adhesive layer, a first black layer, a flexible base layer, a second black layer, and a second pressure-sensitive adhesive layer, wherein said first pressure-sensitive adhesive layer and second pressure-sensitive adhesive layer are the outermost layers on

either side of the double-sided pressure-sensitive sheet, and wherein the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm .

22. (Previously Presented) A double-sided pressure-sensitive sheet comprising, in the following order, a first pressure-sensitive adhesive layer, a first flexible base layer, a first black layer, a lamination layer, a second black layer, a second flexible base layer, and a second pressure-sensitive adhesive layer, wherein said first pressure-sensitive adhesive layer and said second pressure-sensitive adhesive layer are the outermost layers on either side of the double-sided pressure-sensitive sheet, and wherein the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm .

23. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 22, wherein said double-sided pressure-sensitive sheet further comprises a reflective layer situated between the second black layer and the second pressure-sensitive adhesive layer.

24. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 23, wherein said reflective layer is a metal layer.

25. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 23, wherein said reflective layer is a white film.

26. (Previously Presented) A double-sided pressure-sensitive adhesive sheet according to claim 23, wherein said reflective layer is a white printed layer.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE.